

REMARKS

The outstanding issues in the instant application are as follows:

- Claims 1 – 12 and 14 – 21 are rejected under 35 U.S.C. § 103(a).

The Applicant appreciates the Examiner's detailed response to the arguments made in Applicant's previous response. Applicant hereby traverses the remaining outstanding rejections and requests reconsideration and withdrawal in light of the statements contained herein.

Rejections Under 35 U.S.C. § 103(a)

Claims 1 – 12 and 14 – 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,103,265 to Bell, et al. (hereinafter *Bell*) in view of elements claimed as being well-known in the art at the time the invention was made.

Applicant believes that the Examiner understands the arguments being presented by Applicant. The Examiner stated the standard of law that:

obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Final Office Action, p. 10.

The Examiner's application of this standard of law was that "a photographer would not necessarily require the highlighting feature at all times either because of the skill level of the photographer or the ambient scene in which the photograph is to be taken." Final Office Action, p. 10. Applicant respectfully disagrees with the Examiner's conclusion of obviousness based on the asserted knowledge generally available to one of ordinary skill in the art.

The Examiner has a difficult job in assessing obviousness of one or more claims based on the combination of different references and/or common knowledge. It is difficult to

view the issue of the combination of references with only the assumptions common knowledge available at the time these prior inventions were made. It is understandable, as Applicant believes, that hindsight may improperly influence the Examiner's conclusion that a combination may, in fact, be proper.

Bell states that

... [I]t is usually necessary for the operator to determine whether the depth of field is sufficient by observing that the subjects of interest are not blurred in the viewfinder. However, this is a difficult task since, in a depth of field preview mode, the image may be generally dim and thus hard to clearly observe and especially difficult to determine the amount of blur of the subject as compared to the background. This, it is often difficult for operators to determine that the proper subjects are in focus. Col. 1, lns 41 – 50.

As Applicant attempted to explain in the previous Response, the problem, for which the *Bell* invention was offered, was the difficulty to clearly view items from the viewfinder. This problem exists whether or not the user is experienced and whether or not the scene is sufficiently lit. Therefore, according to the teachings of *Bell*, the *Bell* invention is directed to solving this problem.

This particular solution, along with the explanation of the background in *Bell*, give an adequate picture of the common knowledge that may have existed at the time. It would seem logical, as the Examiner has argued, that the functions which address problems that only affect the less-experienced users, such as auto-focus, auto-exposure, red-eye reduction, and the like, would have an on-off switch to disable those features for the more experienced photographers. However, according to *Bell*, the difficulty in making out items in the viewfinder transcends the skill of the user. Therefore, *Bell* does not suggest that an on-off switch would be appropriate. Furthermore, because the general knowledge at the time, as reflected by *Bell*, also would not support the addition of the on-off switch. Therefore, the rejection of claims 1 and 6, as amended, and 17 should be withdrawn.

Claims 2 – 5, 7 – 16, and 18 – 21 depend from claims 1 and 6, as amended, and 17 respectively, and thus inherit all limitations of those respective base claims. Thus, Applicant respectfully asserts that, for the above reason, claims 1 – 12 and 14 – 21 are patentable over the 35 U.S.C. § 103 rejection of record and respectfully request the Examiner to with these rejections.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10005759-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV255077574US in an envelope addressed to: MS AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: January 26, 2004

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Respectfully submitted,



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